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Manoj Modi

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EXAMINER

CHEN, TE Y

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/676,621	<b>Applicant(s)</b> MODI, MANOJ	
	<b>Examiner</b> SUSAN Y. CHEN	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-12,16 and 18-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 7-12, 16, 18-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### ***Response to Amendment***

This office action is in response to the amendment filed on Dec 27, 2007.

Claims 1-2, 7-12, 16, 18-29, are pending for examination; claims 1, 9, 18-19 and 25 have been amended.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As set forth in MPEP 21 06(II)A:

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96),<sup>1</sup> In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 199334. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

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The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application").

Claims 1-2, 7-12, 16 and 18-29, are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 1, 9 and 19, these claims recite a real property information compiling utility via a central database at the preamble, however, the body of these claims lacks an important editing (or aggregation) step to reflect the need for the claimed compiling utility, as such, the claimed utility merely directs to an abstract idea without any real world application, which renders the claims as non-statutory.

As to claim 25, the claim language is being cited in form of means plus function fashion, which seems being implemented by software without being referred to any specific physical devices, as such, it directs the system claim as software per se.

As to claims 2, 7-12, 16, 18, 20-24 and 26-29, these claims fail to resolve the issues as set forth above in their base claims respectively, hence, are rejected for the same reason.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in

anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 7-12, 16 and 18-29, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, it is uncertain what is the claimed “multiple information categories on the central database” (i.e., applicant fails to define the structure of the claimed central database, thus, the multiple information categories is indefinite). In addition, it is unclear what does the claimed “each of the portfolio of real properties” refer to (i.e., is it referred to the portfolio stored in the central database? if so, how could “a stored portfolio” becomes “each of the portfolio”? if not, what are they?)

As to claim 9, it is not understood what does it meant by “each real property within the first set containing sub the same types of real property information”.

As to claims 19 and 25, the claimed “related structures” lacks of antecedent basis because it is not defined by the instant specification.

As to claims 2, 7-12, 16, 18, 20-24 and 26-29, these claims have the same defects as their base claims 1, 9, 19 and 25 respectively, hence, are rejected for the same reason.

Because the ambiguous nature of instant invention, the following art rejection is as to the best the examiner ascertain.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 7-12, 16, 18-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2003/0036963 issued to Jacobson et al. (hereinafter referred as Jacobson) and in view of U.S. Patent Publication No. 2002/0147625 issued to Kolke.

As to claims 1, 9, 19, 21 and 25-29, Jacobson discloses a real property processing system which has means and methods as claimed by applicant, comprising:

providing access to a website for a user [e.g., The one or more Web site pages provided by the property services server platform 145 at Section: 0020];

storing real property information from a portfolio of real properties on a central database [e.g., the aggregated database of the real estate central research center at Section: 0007]. the real properties include land, related structures and infrastructures that were organized into a plurality of records to aid in retrieval of the real property information based on specific requests [e.g., Sections: 0019-0021, the use of portal technique at Sections: 0040 - 0041].

determine the value of each of the portfolio of real properties [e.g., the use of valuation application, ASP modeling and various finance tools processing at Sections: 0037-0039];

retrieving the real property information from multiple information categories on the central database [e.g., the use of central forum technique at Section: 0034];

combining the real property information from the multiple information categories to provide a set of real properties from the portfolio of real properties to be offered as collateral in a loan package such that a valuation of the set of real properties is at least equal to a value of the loan package, each real property within the set containing the same types of real property information [e.g., Sections: 0040-0042];

providing access to the real property information related to the set of real properties to a consumer-specific application through the website by providing a log-in code to the lender [e.g., the use of conventional firewalls and SSL security protocol technique at Section: 0045] , wherein the consumer-specific application makes selection

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to view the real property information which is retrieved from the central database [e.g., the use of portal server, web server, application server and database server at Fig. 2 and associated texts, Fig(s). 3a-g and associated texts] ;

providing search selections for the lender to search based on attributes of the set of real properties, wherein the lender makes selections to view the real property information which is retrieved from the central database [e.g., the on-line search tool at Section:0008]

providing a summary of search results for a plurality of real properties when search selections match more than one real property and displaying the real property information as selected by the lender on the website [e.g., the use of web browser and URL services at Section: 0277-0287, Fig.(s) 3a-g ];

Jacobson did not specifically disclose the real property information being organized in to a plurality of records, including a general purpose record, infrastructure record, business record, accounting record.

However, the claimed features are read by the nature of Kolke's heterogeneous storage [e.g., Sections: 0041, 0044 & 0066].

Jacobson and Kolke are in the same analogous art to manage real property information via network Web browsing service, hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide details of a heterogeneous storage as disclosed by Kolke into Jacobson's invention, because by doing so, the combined methods would have been a prima facie obvious in view of Kolke as discussed above.



As to claims 2, 10-12 and 20, the combined methods of Jacobson and Kolke further discloses the following:

providing access to a second set of real properties from the portfolio of real properties, wherein the second user makes selections through website to view the real property information which is retrieved from the control database [e.g., Jacobson: the use of URL to locate the second set of real properties at Sections: 0277-0287];

accessing the real property information included in the second set from the central database through a communication network [e.g., Jacobson: the use of distributed computer network communication unit 105 at Fig. 1 and associated texts];  
and

displaying the real property information for a user operating a computer system remote from the central database [e.g., Jacobson: Sections: 0033-0034].

As to claim 22, the combined methods of Jacobson, Kolke further discloses the following:

providing search selections for the lender to search based on attributes of the set of real properties [e.g., Jacobson: Section: 0048].

As to claims 16 and 23, the combined methods of Jacobson, Kolke further discloses the following:

providing a summary of search results for a plurality of real properties when search selections match more than one real property [e.g., Jacobson: Sections 0096-0102].

As to claims 7-8, 18 and 24, the combined methods of Jacobson & Kolke further discloses the following:

display only a portion of the real property information for user (or lender) viewing [e.g., Jacobson: Section 0067]; and

adding a second portion of real property information to that approved for lender viewing upon receiving a request from the lender for the second portion of real property information [e.g., Jacobson: Section 0042].

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-2, 7-12, 16 and 18-29, have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN Y. CHEN whose telephone number is (571)272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen  
Partial Sig. Examiner  
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March 28, 2008

/Susan Y Chen/

Partial Sig. Examiner, Art Unit 2161